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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,932

04/08/2004

Samuel S. Fields

41615-0003

9731

43463

7590

05/04/2006

RUDEN, MCCLOSKEY, SMITH, SCHUSTER & RUSSELL, P.A.

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EXAMINER

CHAN, KO HUNG

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/820,932	Applicant(s) FIELDS, SAMUEL S.	
	Examiner Korie H. Chan	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Newly submitted claims 6-10 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Inventions I, claims 1-5, the condiment holder; and II, claims 6-10, drawn to the method of affixing the condiment holder to a vehicle are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product, condiment holder as claimed can be used in a materially different process of using that product such as used as a drink carrying tray by a waiter.

Consequently, claims 6-10 drawn to a method of affixing a condiment container holder to a vehicle is independent and distinct from the original claims 1-5.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 6-10 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other

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information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not provide support for the recitation that "the condiment well does not permit passage of a liquid therethrough", claim 1, last line. The specification makes no mentioning of the fact and the drawings does not clearly proof that the well (26) has a bottom. The end view of Figure 2 merely shows a sidewall of the well and does not show the well with a closed bottom. Figure 1 shows well (26) which can be interpreted as a bottomless well. The different definitions of the term "well" in the dictionary does not necessarily indicate the term "well" has to have a close bottom which does not permit passage of a liquid. Consequently, such recitation is new matter. Further the recitation that the bottom lips

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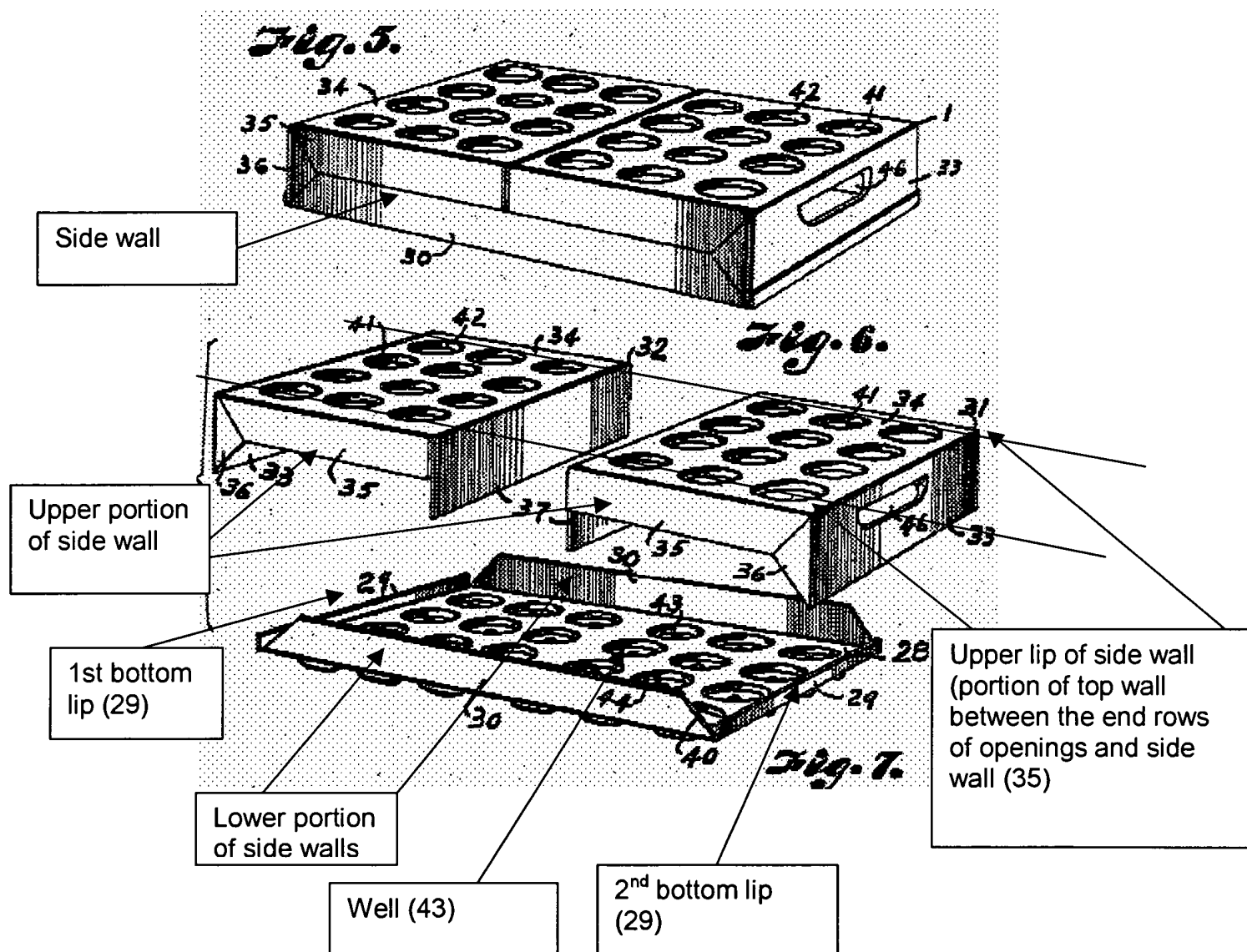
20 and 22 are perpendicular to the bottom is also without support. Examiner cannot find any specific reference in the specification that the bottom lips 20 and 22 are perpendicular to the bottom (24). Further, the drawings also does not give a clear indication that the bottom lips are perpendicular. The lips could be at an oblique angle relative to the bottom when one views applicant's drawings. Drawings in the specification are not in scale and examiner would tend to also reject the claim that the top lips (16 and 18) are perpendicular to the walls (12 and 14). There is no mentioning the specification that these walls are substantially perpendicular.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Comer (US patent no. 2,459,921) in view of Scheurer (US patent no. 5,170,720). Comer discloses all the claimed features of applicant's invention as illustrated below.



However, Comer does not disclose the well does not permit passage of a liquid. Comer does provide an opening (44) in the well for the draining any spilled liquid which is an advancement in the art relative to not providing an opening as in applicant and demonstrated by Scheurer'720. To modify Comer's well so as not to having an drainage opening would have been obvious to one of ordinary skill in the art as such is conventional and well-known in the art as demonstrated by Scheurer.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comer (US patent no. 2,459,921) in view of Scheurer (US patent no. 5,170,720) as applied to claim 1 above and further in view of Grondin (US patent no. 3,168,275). Comer and Scheurer combined disclosed all the claimed features of applicant's invention as illustrated above except for adhesives on the bottom or one of the walls. To provide adhesive as mounting means are conventional and well-known in the art. Grondin teaches a holder with walls (20) with lips (24) and bottom (18) wherein the releasable adhesive material (30, figure 2, and 32, figure 3) can engage the bottom (18) or the wall (20, figure 3) to alternatively mount the holder under different conditions. It would have been obvious to one of ordinary skilled in the art to provide adhesive material to the wall or bottom of the holder of Comer and Scheurer combined since such provision is conventional and well-known as taught by Grondin.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Provost discloses a holder with walls and lips and wells. Tsao discloses a condiment holder of similar type.


Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Korie H. Chan
Primary Examiner
Art Unit 3632

khc
May 2, 2006